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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,962	11/18/2003	Rainer Birkenbach	SCHWP0184USA	5397

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,962

Applicant(s)

BIRKENBACH ET AL.

Examiner

Matthew J Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application due to the handwritten reference numerals. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4-10 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 2, the claim is generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

In regards to claims 4-10, the applicant refers to a system comprising a device, which is not consistent with independent claim 1, a device claim.

In regards to claims 17-18, the applicant refers to a computer program, which is not consistent with independent claim 11, a method claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4-9 and 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,642,836 to Wang et al.

In regards to claims 1-2, Wang et al. disclose a device for coupling at least two medically applicable instruments comprising: a central control unit 12 coupled to input and/or output connections of at least two control apparatuses 14, the central control unit including: at least one processor which (i) receives output signals from the at least two control apparatuses and (ii) converts the output signals into a unified format (see Col. 2, Lines 3-22); and at least one processor 32 which (i) receives inputted control signals, (ii) converts the control signals into formats corresponding to the respective at least two control apparatuses, and (iii) transfers the converted control signals to the at least two control apparatuses 14 to control the at least two medically applicable instruments 16 (see Col. 3, Lines 13-57).

In regards to claims 4, Wang et al. disclose a device for coupling at least two medically applicable instruments having a display device 86 coupled to the central control unit (see Col. 10, Lines 1-2).

In regards to claims 5-6, Wang et al. disclose a device for coupling at least two medically applicable instruments comprising a central input device 32 coupled to the

Art Unit: 3739

central control unit and wherein the input device is a voice control interface (see Col. 5, Lines 7-37).

In regards to claims 7-8, Wang et al. disclose a device for coupling at least two medically applicable instruments wherein at least one of the data output device and the data input device is coupled to the central control unit via a bus, and wherein the bus provides electrical separation between the data input device or the data output device and the central control unit (see Col. 4, Lines 24-36 and Col. 7, Lines 40-51).

In regards to claims 9, Wang et al. disclose a device for coupling at least two medically applicable instruments further comprising a storage unit 44 for storing data captured by the medical instruments and/or data inputted via the data input device (see Col. 5, Line 55 – Col. 6, Line 34 and Fig. 3).

In regards to claims 11-18, the operating control system of Wang et al. is considered to be inherently capable of performing the recited method claims (see Col. 3, Lines 6-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,642,836 to Wang et al. in view of U.S Patent No. 6,117,127 to Helmreich et al.

In regards to claim 3, Wang et al. disclose a device for coupling at least two medically applicable instruments, wherein the instruments are coupled to at least two control apparatus but is silent with respect to the at least two control apparatuses coupled to the at least two medical apparatus being provided in a rack. Helmreich et al. teach of an analogous device for providing a medical workstation wherein all of the handheld instruments and components necessary for conducting a surgical procedure are readily available at a single common location (see Fig. 1). It would have been obvious to one skilled in the art at the time the invention was made to include a rack to hold the control apparatuses in the device of Wang et al. in order to provide a more organized operating environment wherein all components are in a concentrated region as taught by Helmreich.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,642,836 to Wang et al. in view of U.S Patent No. 6,471,363 to Howell et al.

In regards to claim 10, Wang et al. disclose a device for coupling at least two medically applicable instruments, wherein the instruments are coupled to at least two control apparatus but is silent with respect to at least one device forming the system being mounted to a ceiling of an associated operating room. Howell et al. teaches of an analogous device for surgical purposes that is attached to the ceiling of an operating theater and comprises various cameras and monitors, which can be pivoted relative to each other, as disclosed by applicants specification. It would have been obvious to mount at least one device in the system of Wang et al. to the ceiling in order to provide optimal viewing in a surgical environment as taught by Howell et al.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,120,435 to Eino

U.S. Patent No. 4,611,291 to Hoelscher

U.S. Patent No. 5,572,999 to Funda et al.

U.S. Patent No. 5,819,229 to Boppe

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK

MK

1/12/05

B. L. Murphy
BEVERLY M. FLANAGAN
PRIMARY EXAMINER